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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,872	01/25/2002	Alfred A. Norcott	04870.00009	1785

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EXAMINER

CHENG, JOE H

ART UNIT PAPER NUMBER

3713

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,872

Applicant(s)

NORCOTT ET AL.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-27 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is noted that the claimed structural elements cannot perform the function of *testing the user on the educational materials* as claimed (as per claims 19-13, 20 and 24-27). It is suggested to combine the structural elements as claimed in claim 14 to overcome the rejection. In addition, as per claim 19, the recitation therein is indefinite, because it is the system to automatically re-present with the relevant test materials and with the question and is not the user as claimed. Further, the phrase "and/or" (as per claims 19 and 21-25) renders the claim indefinite because it is an alternate expression which is subject to more than one interpretation. Furthermore, the antecedent basis for "said information downstream", "said information upstream" (as per claim 13) and "the presented educational materials" (as per claim 15) has not been clearly set forth. Claims 16-18 are rejected for incorporating the above errors from their respective parent claims by dependency.

Claim Rejections - 35 USC § 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-5, 7-9 and 11-27 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudman et al (U.S. Pat. No. 5,385,475) in view of Guy et al (U.S. Pat. No. 5,833,468). Figs. 1a-19 of Sudman et al broadly discloses the interactive educational system for providing educational material to multiple simultaneous user comprising the central operations, such as computer server (24) having the processor (24c), the storage (24a, 24b) and the input/output (24d) for interaction between the system and a remotely located administrator, for presenting the educational materials, such as audio, video and text data, and the test questions to the user, and for providing report of the interaction of the user, a plurality of terminals (34₁ – 34_n, 36₁ – 36_n, 38₁ – 38_n, 46₁ – 46_n) for the multiple simultaneous users to receive the desired educational materials, and a plurality of bi-directional communications channels for the multiple

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simultaneous user to randomly interact with the central operations. It is noted that the teaching of Sudman et al does not explicitly disclose the modem (as per claims 1 and 24), the telephony channel for upstream record or identification information and video channel for downstream information to the terminals (as per claims 1, 12 and 13) as required. However, Figs. 1-6B of Guy et al broadly discloses that such features of using the telephony channel (210) of the modem for upstream record or identification information and the video channel (208) of the modem for downstream information to the terminals (106) are old and well known. Hence, it would have been obvious to one of ordinary skill in the art to modify the system of Sudman et al with the features of the telephony channel of the modem for upstream information and the video channel of the modem for downstream information to the terminals as taught by Guy et al as both Sudman et al and Guy al are directed to the interactive educational system, so as to provide the educational and testing material to the terminals and to provide the record information, such as user identification and response information to the server. It is also noted that the teachings of Sudman et al and Guy et al do not explicitly discloses the network I/O (as per claims 1 and 24), the internet server (as per claim 4), the program storage/memory (as per claims 5, 9), content storage/content media storage (as per claims 5, 14 and 20), test database, and usage database (as per claim 9), the central operations for evaluating the user's responses (as per claim 16), the web page (as per claim 22), or the local area network or wide area network (as per claim 26) as required. However, such limitations of the storage having the program storage/memory, the content storage/content media storage, the test database, and the usage database, the central operations for evaluating the user's responses, and the network I/O for connecting the internet server thru the local area network or wide area network by using the web page are old and well

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known and are considered an arbitrary obvious design choice, so as to provide the different area of the storage memory for the needed usage, for evaluating the user's response, and using the internet for the interactive educational system.

Allowable Subject Matter

6. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carver (U.S. Pat. No. 5,318,450) - note Figs. 1 and 2;

Cook et al (U.S. Pat. No. 5,727,950) - note Figs. 1-11;

Lotvin et al (U.S. Pat. No. 5,907,831) - note Figs. 1-15B;

Wadahama et al (U.S. Pat. No. 6,024,577) - note Figs. 1-19;

Downs et al (U.S. Pat. No. 6,086,381) - note Figs. 1-5;

Carlile et al (U.S. Pat. No. 6,164,974) - note Figs. 1-6;

Linton (U.S. Pat. No. 6,282,404 B1) - note Figs. 1-19;

Kouba et al (U.S. Pat. No. 6,325,631 B1) - note Figs. 1-8;

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Truluck et al (U.S. Pat. No. 6,353,447 B1) - note Figs. 1-9H;

Aspe et al (U.S. Pub. No. 2002/0187463 A1) - note Figs. 1-10;

Doi et al (U.S. Pat. No. 6,526,257 B1) - note Figs. 1-10;

Joao (U.S. Pub. No. 2003/0110215 A1) - note Figs. 1-7;

Hartman et al (U.S. Pub. No. 2003/0134260 A1) - note Figs. 1-5;

Sutton (U.S. Pat. No. 6,595,781 B2) - note Figs. 1-17;

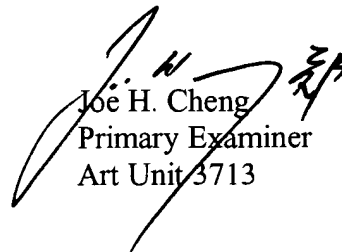
Parker (U.S. Pub. No. 2003/0207245 A1) - note Figs. 1-11.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Mon. - Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and (703)872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng
November 13, 2003


Joe H. Cheng
Primary Examiner
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